

## REMARKS

Applicant submits this response to the Office Action mailed December 19, 2008.

Applicant appreciates the Examiner's thorough review of the application.

The Office Action rejects Claims 1-4, 7, 10-11, 14, 17, 20 and 22 under 35 USC § 103(a) as being unpatentable over European Patent No. 903,288 to Ikuo et al. in view of Canadian Patent No. 1,049,856 to Meindl, and further in view of U.S. Patent No. 4,102,291 to Sebald. Claims 5, 6, 8, 9, 12, 13, 15, 16, 18, 19, and 21 are objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 1 recited a propulsion system that has the ability to use three energy sources, specifically (i) solar energy, (ii) wave or water current energy, and (iii) wind energy. None of the cited references, individually or in combination, disclose, teach or suggest a propulsion system adapted to use all three recited energy sources. The Office Action states that “Sebald discloses a propulsion means for a sailboat and teaches using a propeller to drive a generator to collect energy.” Applicant respectfully disagrees with the Office Action’s interpretation of Sebald.

Sebald discloses the use of an external flexible-shaft propeller to generate energy to power accessory equipment, such as “radios, lights, refrigeration equipment, and miscellaneous marine instrumentation devices” (Col. 1, lines 10-13). Sebald does not disclose using the generated energy to propel the sailboat. Further, Sebald does not disclose any interaction between its energy-generating arrangement and any component of a propulsion system. Thus, Sebald cannot be said to disclose a propulsion system that uses wave or water current energy.

As none of the cited references, alone or together, disclose, teach or suggest a propulsion system adapted to use all three recited energy sources, Claim 1 is patentably distinct from the cited references. Since Claims 2-4, 7, 10-11, 14, 17, 20 and 22 depend from independent Claim 1, these dependent claims are also patentably distinct from the cited references for at least the reason described above.

Even if Sebald can be said to disclose a propulsion means for a sailboat that uses a propeller to drive a generator to collect energy as stated by the Office Action, such as at Col. 1, lines 36-49, Sebald strongly teaches away from such a configuration. Sebald notes that such a configuration is “extremely inefficient” (Col. 1, line 43), to the point of being almost completely

inefficient (see Col. 1, lines 46-49). It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983). Contrast this situation with *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004), in which the Court stated that “the prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed....” Here, Sebald does not merely criticize, discredit, and discourage such a configuration, but does so quite strongly. One skilled in the art would not be motivated to combine such a configuration with the teachings of Ikuo and Meindl because of Sebald’s strong criticism of the configuration.

Despite Applicant’s strong belief that previously presented Claim 1 is patentable as described above, Applicant is herein amending Claim 1 to expedite a Notice of Allowance. In the Office Action mailed December 19, 2008, Claim 8 is indicated to be allowable if re-written in independent form, incorporating all of the limitations of the base claim and any intervening claims. Currently amended Claim 1 incorporates the recitation of Claim 8, albeit without the recitation of intervening Claim 7. Applicant respectfully asserts that the addition to Claim 1 of the recitation of Claim 8 renders amended Claim 1 patentable over the cited references, as none of the references disclose a hybrid propulsion system that includes an electrical machine mechanically coupled to a fluid drive element, in which the electrical machine is supplied from the energy stores to drive the fluid drive element in a motor mode.

For each of the reasons described above, Claims 1-4, 7, 10-11, 14, 17, 20 and 22 are patentably distinct relative to the cited references. Thus, it is respectfully submitted that the rejection of Claim 1-4, 7, 10-11, 14, 17, 20 and 22 is overcome

### CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that all of the claims of the present application are in condition for allowance. It is respectfully requested that a Notice of Allowance be issued in due course. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 50-2127.

Respectfully submitted,

  
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